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REMARKS

Reconsideration of the above identified application is respectfully requested.

Applicant traverses the failure of the examiner to consider the IDS filed 08/14/00; and has filed a "Defective Office Action" paper dated 09/04/02.

In response to that paper, the examiner issued a supplemental office action dated 09/24/02 indicating that the IDS has now been considered; and requesting a duplicate copy of the form PTO-1449. That copy is attached hereto as requested.

Applicant traverses the objection to the drawings as being unwarranted by the examiner's interpretation of the Rules and the MPEP.

More specifically, the examiner's objection pertains to method claims 1-7, which are different than apparatus claims 8-14. Clearly the structural features of the apparatus claims are illustrated in the drawings, along with the flow chart and material browser for the method claims.

The examiner's contention that every claim feature must be shown in the drawings is not an absolute requirement since it is common practice for patents to be granted without any drawings at all; irrespective of the number claims.

Rule 81(a) requires drawings only where necessary for understanding the invention.

Rule 81(b) indicates that the drawings "may include" flowsheets; this is permissive language, not mandatory language.

And, MPEP 608.02(d) states that "structural details" must be illustrated.

Accordingly, Applicant figures 1-3 comply with these provisions for illustrating only the necessary structural details of the claimed apparatus; while additionally illustrating features of the method claims.

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The examiner should not overlook the function of the written specification in describing the method claims for meeting the requirements of Section 112, notwithstanding the drawing. The specification amply supports the method claims, in conjunction with the drawings as originally filed.

Nevertheless, it appears that the drawings already adequately illustrate the very method features being objected to by the examiner.

The user query of claim 1 is illustrated in step 202 of figure 2 (page 8, lines 18+), and in the window 300 of figure 3 (page 9, lines 15+; page 10, lines 4+; and page 3, lines 21+).

The transmitting input of claim 5 is illustrated in step 210 of figure 2 (page 9, lines 11-14).

The list sorting of claim 6 is illustrated in box 302 of figure 3 (page 10, lines 25-27).

The examiner's contention in para. 3 of the office action that the "claims are replete" with drawing errors is traversed; since method claims 1-7 appear to be suitably represented in the drawings, and described in the specification in accordance with the Rules and MPEP.

Should the examiner persist in the objection; Applicant requests the examiner to provide due notice under MPEP 608.02(d) & (e) of each and every occurrence in claims 1-7 being objected to since Applicant cannot speculate as to the examiner's interpretation of the claims and drawings and drawing Rules and MPEP provisions.

Furthermore the examiner's mandate to provide a proposed drawing correction or face abandonment does not appear warranted by any Rule or MPEP provision. That mandate should be withdrawn, or suitable support in the Rules or MPEP be identified therefor.

However, in an abundance of caution, Applicant is nevertheless attaching hereto a proposed drawing amendment in response to the examiner's mandate to illustrate additional

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features of the method claims in a good faith attempt to comply with the examiner's expressed and unexpressed requirements.

Figure 2 has been modified to add additional boxes for price quote, user query, data display, customer application criteria, raw material type, type sort, and cost sort as well described in the specification.

In view of the traverse of the drawing requirement, there should be no need to amend the drawing in response thereto.

Accordingly, withdrawal of the drawing objection is warranted and is requested.

Applicant traverses the rejection of claims 1-14 under 35 USC 112, second paragraph.

The examiner's contention that the claims "are replete with errors" neither identifies those alleged errors, nor is substantiated by Rule or MPEP.

Regarding claims 1 and 8, the "material types" objected to by the examiner under MPEP 2173.05(b)E is not the same type of "type" addressed in that MPEP provision. That provision deals with hyphenated -types, which are not found in claims 1 and 8.

The claims must be examined by the examiner for the express claim recitations therein, not for re-characterizations thereof by the examiner. Claims 1 and 8 expressly recite a "raw material type" and that expression is defined in the specification at page 9, lines 22+, for example, as the several line entries 304 shown in figure 3, with each raw material type having the various attributes specifically identified in columns 306-316.

The specific raw material itself is identified by the material number or code illustrated in column 306.

Applicant recognizes the examiner's "ordinary meaning" contentions presented in para. 10; yet that ordinary meaning must be given ordinary mean based on not only the individual words, but combinations thereof, especially when read in light

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of the specification to one skilled in the art as required under Section 112.

Claims 1 and 8 do not recite "raw," or "material," or "type," as well as other naked words, alone in a vacuum, but in various combinations, and the examiner has failed to accord due meaning and due weight to those combinations of words, and the combination of meaning therefrom when read in light of the specification.

There can be no doubt that claims 1 and 8 do not recite the hyphenated -type of MPEP 2173.05(b)E, rendering this provision inapplicable; but these two claims recite "raw material type" and that raw material type is so used in the specification and suitably defined therein with suitable definiteness and without being vague. See again items 304.

The examiner's contention that claims 2-4 are indefinite for failure to "recite any additional method step" is both incorrect, and not supported by any identified Rule or MPEP provision, and Erlich is inapposite.

The claims 6 and 7 in Erlich recited process of using antibodies of claim 4 therein; and Applicant's claims 2-4 are not analogous process-of-use. See MPEP 2173.05(q) which indicates that Erlich is irrelevant to claims 2-4.

Patent Rule 75(c) merely states that dependent claims are written for "further limiting another claim" and claims 2-4 well comply therewith by further limiting features of claim 1.

It is fundamental claim practice that each and every claim must be evaluated on its own merits, and each and every claim is no different than a corresponding independent claim thereof.

Dependent claims 2-4 must be read as combination claims with claim 1 from which they depend; and clearly recite corresponding process steps of different scope well meeting Rule 75(c).

The examiner's contentions in para. 5c regarding claim 1 are without merit or due weight to the express claim language

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when read in light of the specification.

That "any consumer information would meet this limitation" only relates to claim breadth, and in accordance with MPEP 2173.04 claim breadth does not mean "indefiniteness" as the examiner contends.

*not really!*

Furthermore, the examiner's recharacterization of the express language of claim 1 as being "any consumer information" is evidence of the failure by the examiner to accord due weight to the express claim language, which is quite different.

Claim 1 recites a method of selecting a raw material for which the "customer application criteria" is related. The "any consumer information" clearly is not related to either selecting raw material or customer application criteria, and the examiner has not shown otherwise, notwithstanding the elaborate contentions presented by the examiner in para. 10 of the office action including "broadest reasonable interpretation." That broadest reasonable interpretation must be based on the **actual** claim features, not re-characterized claim features like "any consumer information" having no substantiated relevance to Applicant's claims.

The examiner's additional contention in para. 5c that "'selection' makes the claim [1] unclear" fails to accord due weight to express claim language when read in light of the specification using the ordinary meaning thereof, and is not substantiated.

Claim 1 recites both "consumer application criteria" and a corresponding "selection" thereby, both of which expressions are well described in the specification. The criteria is disclosed in the specification at various locations including page 5, lines 3+, and illustrated in the filter area 318.

The various filters in drop-down list form 322-330 permit the user to make a "selection" in step 204 as described at page 8, lines 23+.

Accordingly, claim 1 well describes without being

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indefinite or unclear as the examiner contends, that the user is queried for a "customer application criteria selection," a straight forward and simple concept, and a concept illustrated quite simply in the web browser of figure 3 at filter box 318.

*Conditional* Regarding the examiner's contention in para. 5d, the issue is not whether "a" and "b" in claim 1 are "disjunctive or conjunctive expressions," but whether the claim is definite under Section 112.

Claim 1 clearly recites "if-then" provisions for the method: if said user input is (a) raw material selection, then display ...; and if (b) customer application criteria selection, then display .... Note the conjunctive "and."

Accordingly, withdrawal of the rejection of claims 1-14 under 35 USC 112, second paragraph, is warranted and is requested.

Applicant notes the substantial breadth of interpretation of Applicant's claims being proffered by the examiner, which correspondingly enlarges claim scope in later infringement analysis of the file wrapper. However, the examiner has failed to afford due weight to specific features and cooperation of features which distinguish over the applied art.

*Purcell* Applicant traverses the rejection of claims 1, 5-8, and 12-14 under Section 102(e) over Purcell.

Independent claims 1 and 8 both recite customer application criteria (318) and raw material type (304) which appear to be lacking in Purcell. These two features are separately recited, and are correspondingly different from each other, and it is not seen how the examiner can interpret Purcell for both such features in the cooperation recited in claims 1 and 8.

Purcell presents one example at col. 9, lines 34+, including standard information in a plurality of fields. The seller's product information exchanged is 'casing piping of various sizes, wall thicknesses, and thread specifications."

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At col. 10, lines 1+, the buyer's choice is limited to tubing casings corresponding with casing pipe.

How then does Purcell disclose or suggest the disparate criteria and raw material type recited in claims 1 and 8, when no such features appear disclosed therein? Even the broad interpretation of both Applicant's claims and Purcell, cannot be used to disregard the fundamental differences therebetween.

The examiner's contentions are conspicuous in failing to identify specific features in Purcell corresponding with specific features in Applicant's claims. The mere recapitulation by the examiner in para. 7 of Applicant's own claim terms does not mean that such features are found in Purcell; and the rejection therefore lacks evidentiary substantiation.

Furthermore, claims 1 and 8 recite two if-then features which the examiner has failed to identify in Purcell. The "criteria for the display listing" at col. 7 of Purcell being used by the examiner does not appear to match both if-then displays recited in the claims, and the examiner has not shown otherwise.

Regarding claims 5 and 12, the examiner's mere reference to the "information exchange system (05)" of Purcell, see col. 8, lines 66+, appears to use the same system 05 for both basic method/system introduced in claims 1 and 8, and the separately recited price system in claims 5 and 12. It is fundamental under Section 102 that the same element in a reference cannot be used for two separately-recited features in patent claims. The examiner must find in Purcell separate elements corresponding to the separate features recited in Applicant's claims; and has not.

Claims 6 and 13 recite sorting the list of raw material types displayed to the user in combination with the two if-then provisions which appear wanting in Purcell; and the examiner's mere recapitulation of Applicant's features does not show otherwise.

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Claims 7 and 14 recite sorting the raw material type by "unit cost." The examiner's mere contention that the "goods and services [of Purcell] may be sorted by material to be purchased or price" clearly fails to afford due weight to these claims.

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That Purcell "may sort by price" does not so support a rejection under Section 102, which requires identity of recited elements. And, the examiner has failed to establish that "price" in his contention is analogous to the "unit cost" recited in these claims. Price may be price; but unit cost is unit cost, and they are clearly not the same. If a seller were to sell his products for "cost" and not "price," that seller would certainly fail in business.

It is noted that the examiner has failed to reject claims 2-4 under Section 102, yet has inexplicably rejected claims 9-11 which correspond thereto in the system claims. This is a clear admission that Purcell fails to disclose the criteria of claim 9; the information of claim 10; and the pressure sensitive material of claim 11, rendering the rejection thereof under Section 102 without evidentiary basis.

Accordingly, withdrawal of the rejection of claims 1, 5-8, and 12-14 under Section 102(e) over Purcell is warranted and is requested.

The examiner's contentions presented in paras. 9-10 are positioned **after** completion of the Section 102 rejection and **before** the introduction of the Section 103 rejection, and therefore have not been tied to any rejection at all. Those contentions in general would appear to be irrelevant; and would require the Applicant to speculate on the examiner's use thereof. The MPEP requires more from the examiner in establishing rejections in the first instance.

Nevertheless, the examiner's contentions in para. 9 are not supported by the MPEP, or relevant to Applicant's claims under the cited case Bristol-Myers.

MPEP 2173.05(g) states that "functional" features are not



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improper, and must be given due weight, not "less weight" as the examiner has admitted to.

How is the examiner's mere contention of "intended use" relevant to method claims 1-7 when use is the sine qua non of method claims? And, how has the examiner distinguished mere "intended use" from proper functional cooperation of elements expressly presented in the bodies of claims 8-14? *(in brackets)*

Regarding Bristol-Myers, the examiner has failed to first establish that the factual basis of that case and Applicant's claims are related in any manner. The examiner presents Bristol-Myers for a method claim stating "only a purpose and intended result" when method claims 1-7 do much, much more; which the examiner has apparently overlooked.

Regarding the examiner's contentions in para. 10, lexicographer and ordinary meaning notwithstanding, Applicant's claims must be read, not on naked words out of context, but combinations of words in context of the corresponding claims when read in light of the specification by one skilled in the art.

The various terms used in Applicant's claims are well defined in the specification at many locations, apparently overlooked by the examiner. "Failure-by-the Applicant," or not, to address the claim features in this response does not diminish the examiner's duty to evaluate those claim features in their "ordinary" sense when read in light of the specification. And, of course, common USPTO practice of "broadest reasonable interpretation" only broadens Applicant's claims for subsequent infringement analysis of the file wrapper; yet is nevertheless limited by the plain meaning of those terms when read in light of the specification.

*(handwritten mark)* Since the examiner has failed to indicate which terms require any special interpretation, then the various claim terms must be read in light of the specification nevertheless.

However, the specification contains various definitions of various terms relevant to the various claims.

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Raw material is disclosed at page 1, lines 15,23; page 2, lines 8+; and page 5, lines 8+.

Raw material type is disclosed at page 1, line 18; page 8, lines 22+; and page 9, lines 22+ (304).

Raw material code is disclosed at page 1, line 25; page 2, lines 18+; and page 9, lines 24+ (306, e.g. code number CL-115).

Raw material information is disclosed at page 3, lines 24+; page 5, lines 13+; and page 10, lines 20+ (332).

Customer application criteria are disclosed at page 3, lines 17+; page 5, lines 4+; and page 10, lines 4+ (318).

Customer's documents are disclosed at page 1, line 21.

Print methods are disclosed at page 2, lines 13+.

Adhesive types are disclosed at page 2, lines 14.

Facestock types are disclosed at page 2, lines 14+.

These are just examples; with the specification being replete with the ~~same~~ terms used in the various claims. It is these terms used in Applicant's claims, and well described in the specification which should be given due weight, ordinary meaning, and broad interpretation when read in light of the specification.

And, correspondingly, the examiner is also duty bound to afford due weight to terms found in the applied art when read in light of the disclosures thereof as would be interpreted by one skilled in the art.

Applicant traverses the rejection of claims 2-4 and 9-11 under Section 103(a) over Purcell and Herridge et al.

*He 1021*  
*He*  
*14*  
The examiner's simplistic contentions presented in para. 12 fail to meet the specificity requirements of MPEP 706.02(j) and the legal motivation requirements in ch. 2100 in evaluating these claims in the whole and the applied references in the whole.

The examiner contends that "Purcell discloses as discussed above;" but what? Para. 7 of the office action describes features of Purcell pertaining to "goods and

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services," but of what relevance is this to the claims now being rejected under Section 103?

Purcell "does not directly disclose adhesive type and description of the adhesive," yet Purcell does not disclose an infinite variety of things, or the infinite variety of elements found in the six million plus issued US patents in the USPTO database.

The examiner then applies Herridge for its adhesive disclosure; and merely contends: "Therefore, it would have been obvious ... to modify Purcell ...."

Where is any nexus, any nexus in the first instance between these disparate references; why not select any of the other six million plus US patents?

"Modify Purcell;" how?

How do these mere examiner assertions, clearly being made in hindsight, comply with the specificity requirements of MPEP 706.02(j)?

"Such a modification would have allowed buyers and sellers of adhesive tape components ... to be electronically linked...." This is blatant hindsight conclusion, and not the legal motivation required by MPEP ch. 2100; and this disregards the very claims being rejected.

How are Purcell and Herridge related by problems to be solved? What problem in Purcell is being solved by the solution in Herridge?

Claims 2 and 9 recite certain customer application criteria. What is the customer application criteria in Purcell? And, how is that criteria related to Herridge? Why would one skilled in the art take from Herridge only the adhesive as the examiner contends and somehow combine it with the products of Purcell? Is the adhesive in Herridge relevant to the casing pipe in Purcell, or some other product therein?

Claims 3 and 10 recite certain material information which is a different element than the customer application criteria recited in claims 2 and 9. How can the one adhesive of

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Herridge being used by the examiner be used against two different features in these claims?

Claims 4 and 11 recite that the raw material is a pressure sensitive material, yet of what relevance is the adhesive to the casing pipe example in Purcell, or any other example therein?

Broadest reasonable interpretation, and ordinary meaning of terms does not give the examiner license to disregard the stringent requirements of MPEP 706.02(j) and ch. 2100. The examiner's contentions in para. 12 of the office action are classic hindsight, without a showing of any nexus whatsoever between the disparate references Purcell and Herridge; without regard to the whole teachings thereof; without regard to the whole of Applicant's claims; without regard to problem solving; and without regard to legal motivation requirement of MPEP ch. 2100.

In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999), emphasizes the evidentiary showing required by the USPTO in supporting an obviousness rejection for avoiding impermissible hindsight. The USPTO rejected as obvious claims for a trash bag colored orange in imitation of a pumpkin and decorative face for Halloween. The USPTO cited many references for creating Jack-O-Lantern bags, including conventional plastic lawn or trash bags. The Federal Circuit reversed the obviousness rejections as hindsight-based, and summarized previous cases:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.... [In re Rouffet] "the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them." [In re Fritch] examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the

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combination]." [In re Fine] evidence of teaching or suggestion "essential" to avoid hindsight. [Ashland Oil] district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination." [Graham] "strict observance" of factual predicates to obviousness conclusion required. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability --- the essence of hindsight. [Interconnect Planning Corp.] "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved.... although "the suggestion more often comes from the teachings of the pertinent references...." The range of sources available, however, does not diminish the REQUIREMENT FOR ACTUAL EVIDENCE. THAT IS, THE SHOWING MUST BE CLEAR AND PARTICULAR.... Broad conclusory statements regarding the teaching of multiple references, standing alone are not "evidence...." In addition to demonstrating the propriety of an obviousness analysis, PARTICULAR FACTUAL FINDINGS REGARDING THE SUGGESTION, TEACHING, OR MOTIVATION TO COMBINE serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. Here, however, the Board did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references....

Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific - or even inferential - findings concerning the identification of the relevant art, the nature of the PROBLEM to be solved, or any other factual findings that might serve to support a proper obviousness analysis.

To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references CAN be combined to

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read on the claimed invention. For example, the Board... concludes that the *SUBSTITUTION* of orange plastic for the crepe paper of Holiday and the paper bags of Shapiro would be an *OBVIOUS DESIGN CHOICE*... Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate *HOW* the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. See Rouffet... noting Board's failure to explain, when analyzing the prior art, "what specific understanding or technical principle... would have suggested the combination." Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. [emphasis added]

Accordingly, withdrawal of the rejection of claims 2-4 and 9-11 under Section 103(a) over Purcell and Herridge et al is warranted and is requested.

However, in order to promote the present prosecution, Applicant is nevertheless amending the claims to further distinguish over the applied art.

Independent claims 1 and 8 have been similarly amended to recite querying for both customer application criteria selection and raw material type selection; and that the list of raw material types has various customer application criteria correspond with each material type. This is disclosed in the specification at page 3, lines 21+, for example.

As indicated above, Purcell fails to disclose a method or system for selecting raw material including the use of both the criteria selection and type selection; and display thereof in response to corresponding user input.

Claims 2 and 9 have been amended to recite the entire list of criteria, which is particularly relevant to selecting raw material for pressure sensitive products.

Purcell and Herridge fail to disclose or suggest the association of (plural) criteria to raw material selection in

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the manner recited in these claims.

Claims 3 and 11 have been amended to recite the entire list of raw material information having no counterpart in Purcell and Herridge.

In view of the fundamentally different nature of Applicant's method and apparatus over the references of record, Applicant has chosen to add claims 15-30.

Independent method claim 15 recites a method of selecting a raw material 306 for manufacturing a product therefrom comprising:

storing (110) a list of different raw materials 306, with each of the raw materials having various customer application criteria 304 stored therewith, and the criteria being indicative of intended application of the raw material in a product;

populating (104) a plurality of filter lists 318 corresponding with the stored customer application criteria for the different raw materials;

displaying (112) a material browser 300 including a plurality of filters 322-330 corresponding with the filter lists;

selecting one of the filter lists and specifying a filter criterion therein;

filtering the list of raw materials to obtain a filtered list thereof matching the filter criterion; and

displaying (302) in the browser the filtered list of raw materials matching the filter criterion.

These features are disclosed in the specification at page 1, lines 9+; page 2, lines 2+; page 3, lines 16+; page 5, lines 2+; page 6, lines 8+; page 8, lines 18+; page 9, lines 15+; page 10, lines 4+; and page 11, lines 17+.

Of particular significance in claim 15 is the method which permits a user to search for raw materials based on the criteria of intended application. Note, the Background section explains the problems in manufacturing form-label

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documents in which the raw materials have various attributes (criteria) for only certain intended applications of the final product. The failure to select a suitable raw material, out of many available, can result in an unacceptable product.

The recited method includes special application criteria for filtering by the user in defining the specifications for a final product for an intended application.

This is quite different than the disclosure of Purcell in which an information exchange is provided for various products and services between sellers and buyers. There appears to be no teaching in Purcell of searching for raw material using filters for application criteria in the manner recited in claim 15.

Note that the casing pipe example disclosed at col. 9, lines 47+, of Purcell merely includes pipes of various sizes, wall thicknesses, and thread specifications. There appears to be no operation in Purcell of selecting a raw material for manufacturing a product for an intended application.

There is no disclosure in Purcell of where the casing pipe might be used, and in what product that pipe might be incorporated. Purcell appears to simply disclose an information exchange system for buyers and sellers of mere products and services, without regard to what those products and services are; and without regard to the use of those products and services in manufacturing a product in the manner recited in claim 15.

Claim 16 recites displaying also in the browser the various customer application criteria corresponding with each of the raw materials in the filtered list, as disclosed at page 9, lines 22+.

It does not appear that the criteria disclosed in Purcell is presented in the manner recited in claim 16, nor contains the specific type of information recited in this claim.

Claim 17 recites selecting a plurality of the filter lists and selecting corresponding filter criterion therefor;



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and filtering the list of raw materials to obtain the filtered list thereof matching the filter criteria corresponding with the selected filter lists as disclosed at page 10, lines 4+.

It does not appear that Purcell discloses populating a plurality of filter lists with the specific criteria recited in this claim; nor that Purcell would enjoy the same operation and benefits in manufacturing a product.

Claim 18 recites additionally storing with the list of raw materials raw material information corresponding with each of the raw materials including information different than the customer application criteria and information specific to permitted applications of the raw material in a product; selecting one of the raw materials from the filtered list; and displaying in the browser the raw material information corresponding with the selected raw material as disclosed at page 2, lines 24+; page 4, lines 1+; page 10, lines 17+; and page 15, lines 7-10.

Purcell discloses one set of criteria for its products and services, which does not appear to relevant to the different forms of criteria and information recited in this claim. Claim 18 enables the user to select applicable raw materials for permitted applications; a capability wanting in Purcell which discloses a mere information exchange of products and services offered between sellers and buyers.

Claim 19 recites that the product comprises a pressure sensitive material; and the raw material information comprises master width, areas of concern regarding use of the raw material, description of facestock, description of adhesive, description of liner, and description of typical applications for which the selected raw material may be used as disclosed at page 1, lines 18+; page 2, lines 2+; page 5, lines 13+; and page 15, lines 7+.

There appears to be no such product or information in Purcell, nor does Herridge disclose these attributes in any way relevant to the disparate teachings of Purcell.

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Claim 20 recites that the product comprises a pressure sensitive material; and the customer application criteria comprises print method, adhesive type, minimum temperature for adhesive type, service range of adhesive type, and facestock type as disclosed at page 1, lines 18+; page 2, lines 2+; page 3, lines 17+; page 5, lines 19+; and page 10, lines 4+.

Purcell is clearly lacking in these features, and Herridge fails to disclose these features in any way relevant to Purcell.

Claim 21 recites sorting the filtered list by unit cost of the raw materials as disclosed at page 10, lines 25+. As indicated above with respect to claims 7 and 14, neither Purcell nor Herridge disclose or suggest sorting the specific form of criteria recited in this claim, or sorting that information on unit cost.

Claims 22-26 & 30 are apparatus claims corresponding with method claims 15-21, reciting features in the means-for terms of Section 112, 6th para. These claims are similarly distinguishable over Purcell and Herridge for the reasons presented above since Purcell and Herridge fail to disclose or suggest a corresponding apparatus configured in the same manner.

It should be well recognized that the apparatus claims are implemented in a computer system, and a computer system is patentably distinguishable over other computer systems based on the specific programming thereof, specific functions effected, and the specific operation. There appears to be no evidence in Purcell and Herridge that the information exchange system of Purcell could or would be configured in the specific manner recited in claims 22-26 and 30, with the specific data, with the specific function, or for the specific purpose.

Claim 27 recites that the print method comprises cut sheet lap joined, cut sheet laser, direct thermal, thermal transfer, and impact.

Claim 28 recites that the adhesive type comprises

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permanent, cold temperature, and removable.

And, claim 29 recites that the facestock type comprises paper, kimdura, 100# tag, 7 pt tag, 8 pt tag, matte litho, latex impregnated, gloss, matte chrome polyester, bright chrome polyester, clear polyester, white polyester, polyolefin, and vinyl.

Claims 27-29 are disclosed at page 22, lines 12+, and are specific to the selection of raw materials for manufacturing a pressure sensitive document in the exemplary form of labels.

Label production has the special problems disclosed in the Background section in view of the myriad permutations of label elements used in producing various forms of the products for various applications.

Claims 27-29 provide an apparatus specific to the selection of raw materials in the production of label products for enjoying the many benefits disclosed in the specification. Clearly, Purcell and Herridge fail to disclose or suggest any comparable apparatus for selecting raw materials in the manner effected by the claimed apparatus.

The additional references cited, but not applied, have been noted. These references are indicative of the patentably distinguishing nature of computer-based inventions specific to the functions thereof. Similarly, Applicant's claims recite specific elements having specific function and specific operation unlike that disclosed in the applied reference Purcell, with Herridge being merely exemplary of one type of adhesive product having no disclosed technical or logical or legal nexus with Purcell.

In accordance with the duty imposed by 37 CFR 1.104 and MPEP sections 707, 707.05, 707.07, and 707.07(g), the examiner is requested to reconsider all the art of record, including the additional references not applied, to ensure full compliance with the required thoroughness of examination.

In re Portola Packaging, Inc., 42 USPQ2d 1295 (Fed. Cir. 1997) emphasizes the importance of complying with this duty to

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ensure that all references of record have been fully considered by the examiner in the various combinations thereof. And, the Board of Appeals has further elaborated on the importance of this examiner duty in Ex parte, Schricker, 56 USPQ2d 1723 (B.P.A.I. 2000).

In view of the above remarks, allowance of all claims 1-30 over the art of record is warranted and is requested.

Please charge the required fee for added claims 15-30, and any deficiency associated with this amendment, to Deposit Account No. 14-0225 of NCR Corporation in accordance with attached Fee Transmittal for FY 2002.

Respectfully submitted,



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Appendix: pages 29-31

Attachments: One-page Fee Transmittal for FY 2002  
Form PTO-1449  
Proposed amendment of figure 2